

REMARKS

Claims 1-12 are pending. Claims 2-6, 8 and 10-12 have been amended without changing their scope in any way. In particular, claims 2 and 6 have simply been rewritten in independent form, without narrowing their scope in any way. The other amendments are to make strictly informal changes. Claims 1, 2, 6, 7 and 9 are the only independent claims.

The certified copy of the Japanese priority document was filed together with the original application papers for the present application. However, the Office Action summary did not indicate receipt of the claim for priority; or the submission of the priority document. The Examiner is requested to acknowledge receipt of the certified copy in the next Office Action.

Claims 2 and 6 were indicated in the Office Action as being allowable if rewritten in independent form. Since these claims have been so rewritten, they are believed now clearly in condition for allowance.

Claims 1, 4, 5, 7, 9 and 12 were rejected under 35 U.S.C. § 103 as obvious from U.S. Patent 6,104,714 (Baudelot). Applicants traverse and submit that independent claims 1, 7 and 9 are patentable for at least the following reasons.

Claim 1 is directed to a broadcasting control system in an ATM ring network in which a control cell containing control information is transmitted by ATM (Asynchronous Transfer Mode) between a plurality of nodes connected into a ring shape. Each of the nodes includes: receiving means for receiving a control cell from an upstream node, and transmitting means for writing response information of the self node for the control information contained in the received control cell in an area corresponding to the self node in the control cell and transmitting the control cell to a downstream node.

A noteworthy feature of claim 1 is that the transmitting means of a node writes response information of the self node for the control information contained in the received control cell in an area corresponding to the self node in the control cell and transmits the control cell to a downstream node. For example, as discussed in the specification with reference to Figure 1, a control user cell A1 sent from the node 1-1 is input to the node 1-2 through the downstream transmission line 102. The node 1-2 *rewrites a data portion related to itself in the received cell A1 to response data* and sends a rewritten cell A2 to the downstream node 1-3. Of course, the invention is not limited to the disclosed embodiments.

In the Office Action, it is conceded that Baudelot does not contain any teaching of the above-mentioned feature. In fact, Baudelot shows that information of different nodes is assigned to different time slots *in the data cell*. In spite of these differences, the position was taken that it would have been obvious to change Baudelot to place the information of the different nodes in the control node.

First, even if there would have been some motivation to make this modification to Baudelot, and there is none, as will be discussed below, the modified Baudelot would still not meet the feature of claim 1 discussed above. That is, simply having information of different stations in the control cell of Baudelot would still not meet the feature that the transmitting means of a node *writes response information of the self node* for the control information contained in the received control cell *in an area corresponding to the self node* in the control cell.

Second, the Office Action provided no motivation whatsoever as to why one of ordinary skill in the art would actually modify Baudelot to meet the claim feature in question. In particular, to establish a prima facie case of obviousness requires that each and every feature in the claim be taught or suggested in the prior art. Further, for any proposed modification of a reference, the Examiner must provide a motivation, found in the prior art, that would have

caused a person of ordinary skill in the art to make the proposed modification. There must be a reasoned basis for such a finding, based on the prior art itself, and not upon applicants' own disclosure.

In this case, no legally-acceptable reasoning was provided as to *why* one would make the proposed modification of Baudelot. After explaining how Baudelot differs from claim 1, the Action says, at the top of page 3, says: "[t]herefore, it would have been obvious . . . to replace the arrangement of information in the control cell with the arrangement of information in the data cell... so that one cell can be used to write information for many nodes and [utilize] bandwidth of the ring more efficient[ly]." This is in effect saying that it would have been obvious to modify the prior art to meet the claim feature because then you would have certain advantages of the claimed feature.

The fact that the features of the applicants' invention would increase efficiency is *not* evidence that it would have been obvious to have added to the prior art the features that promotes such efficiency. On the contrary, the fact that the prior art had no teaching of a feature, combined with the fact that the feature is advantageous, is evidence of non-obviousness, not its opposite. If the rule followed by the Office Action were to be followed, then the most advantageous inventions would be the most obvious. Of course this is not true.

The only motivation for modifying Baudelot as proposed in the Office Action is to attempt to meet the features of claim 1, which is, of course, improper and amounts to a hindsight reconstruction of the claim. In view of the Office Action's failure to provide any legally acceptable motivation to modify the reference as proposed, no prima facie case of obviousness has been set forth. For at least this additional reason, claim 1 is believed patentable over the cited art.

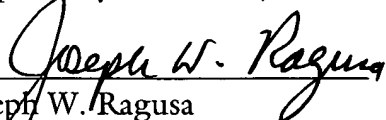
Independent claims 7 and 9 recite, inter alia, similar features and were rejected based upon the same flawed (or absent) reasoning, and are believed patentable for at least the same reasons as claim 1.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Dated: June 2, 2003

Respectfully submitted,

By 
Joseph W. Ragusa

Registration No.: 38,586
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant